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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte URI GELLER

Appeal 2008-1987
Application 09/757,609
Technology Center 2400

Decided: December 1, 2008

Before ALLEN R. MACDONALD, LINDA E. HORNER, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-22. We have jurisdiction under 35 U.S.C. § 6(b).¹ We affirm.

¹ An oral hearing was scheduled for this appeal on November 20, 2008, but Appellant did not appear for the hearing. Accordingly, the oral hearing was waived.

STATEMENT OF THE CASE

Appellant invented a child adoption proceeding in the form of a television game show and online media event where “parent-contestants”² compete against each other to win legal custody of a child. Specifically, viewers and Internet users can vote for the winning parents. Such a technique is said to overcome the inequities of state-run and private adoption procedures by permitting a fairer selection process by enabling viewers to vote on the most capable parents.³ Claim 1 is illustrative:

1. A method for selecting adoptive parents, comprising:

providing a plurality of parent-contestants;

broadcasting to multiple receiving units, each comprising a video display, images of said parent-contestants; and

awarding at least one child available for adoption to at least one winning parent-contestant.

The Examiner relies on the following prior art references to show unpatentability:

Brasseur	US 6,439,997 B1	Aug. 27, 2002 (filed Aug. 30, 2000)
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² According to the Specification, the term “parent-contestants” “refer[s] to a prospective parental entity, which typically is a husband and wife couple, although this term also is construed to include same-sex unions, or even single individuals, who desire to become parents” (Spec. 4:11-14).

³ See generally Spec. 4; Abstract.

AdoptionSolutions.com website printout, 1999 (“Adoption Solutions”).⁴

The Examiner rejected claims 1-22 under 35 U.S.C. § 103(a) as unpatentable over Brasseur and Adoption Solutions (Ans. 3-8).

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Briefs and the Answer⁵ for their respective details. In this decision, we have considered only those arguments actually made by Appellant. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Regarding representative claim 1,⁶ Appellant argues that there is no reason to combine the references in the manner proposed by the Examiner. Appellant emphasizes that Brasseur has nothing to do with child adoptions, but rather involves a game show where viewers participate and vote to select a winner of a monetary award that must be spent within a fixed time period.

Appellant adds that Adoption Solutions has nothing to do with a game show, nor does it provide any means by which the user can vote to select a winning parent. Rather, Appellant argues, Adoption Solutions is an Internet registry for prospective parents hoping for adoptions and children waiting

⁴ Although this reference is undated, the Examiner indicates that its publication date is 1999 (Ans. 3). Since Appellant does not dispute this publication date, we therefore presume that this publication date is correct.

⁵ Throughout this opinion, we refer to (1) the Appeal Brief filed Mar. 27, 2007; (2) the Examiner’s Answer mailed Aug. 8, 2007; and (3) the Reply Brief filed Oct. 9, 2007.

⁶ Appellant indicates that all claims stand or fall with independent claims 1 and 16 (App. Br. 4). Since the independent claims were argued together (along with the dependent claims), we select claim 1 as representative of all claims on appeal. *See* 37 C.F.R. § 41.37(c)(1)(vii).

for adoptions (App. Br. 7-8). According to Appellant, since Adoption Solutions already provides a complete solution to the problem it seeks to solve, there is no reason why this existing solution would be converted into a game show (App. Br. 12; Reply Br. 1-2).

Appellant also cites a newspaper article from 2004 pertaining to a promotion of the ABC News program “20/20” involving a competition among five couples to adopt a teen mother’s baby (Evid. App’x.). According to the article, several adoption professionals indicated that characterizing the adoption process as a competition was “inappropriate and insensitive” (*Id.*). This negative characterization, Appellant argues, evidences the non-obviousness of the claimed invention as it shows the claimed invention runs counter to the accepted practices in the adoption industry (App. Br. 13-14).

The Examiner responds that there is sufficient reason to combine the cited references. According to the Examiner, both references (1) use the Internet as a means to interact with users, and (2) provide profiles of prospective “contestants” interested in an “incentive” (e.g., an adoption-ready child in Adoption Solutions). Based on these common attributes, the Examiner takes the position that using a game show to “award” an adoption-ready baby to a prospective couple would have been obvious to skilled artisans in light of the collective teachings of Brasseur and Adoption Solutions (Ans. 10-11).

The Examiner adds that the cited newspaper article does not establish the non-obviousness of the claimed invention since the article was published three years after the filing date of the present application and, in any event, does not establish a consensus on various adoption methods. In this regard,

the Examiner notes that at least one couple cited in the article is “sympathetic to the process” (Ans. 11).

The issue before us, then, is as follows:

ISSUE

Has Appellant shown that the Examiner erred in rejecting representative claim 1 under § 103 over the collective teachings of Brasseur and Adoption Solutions? The issue turns on (1) whether there is a reason to combine the references in the manner proposed by the Examiner to arrive at the claimed invention, and (2) whether the submitted evidence is sufficient to overcome the Examiner’s *prima facie* case of obviousness.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Brasseur discloses a television game show that awards a large sum of money each week to a selected winner. The winner, however, must spend the money within a particular time frame; otherwise, the money is lost (Brasseur, col. 1, ll. 5-10; col. 2, ll. 42-56).

2. In Brasseur, users register as contestants for the game show and create profiles via the Internet. Each week, ten contestants’ entries are randomly selected as that week’s finalists. The finalists’ profiles are then posted on a website for review by viewers (Brasseur, col. 3, l. 55 - col. 4, l. 3; col. 4, ll. 65-67; col. 1, ll. 34-37).

3. In Brasseur, viewers then vote for a particular finalist via the Internet. The finalist with the most votes will become the winner for the next week's show (Brasseur, col. 4, ll. 1-6; col. 1, ll. 37-42).

4. Adoption Solutions is a website that provides, among other things, a searchable database of parents hoping to adopt a child (the "Parent Registry") and photo listings of children available for adoption (Adoption Solutions, at 2-6).⁷

5. A particular child's listing on Adoption Solutions includes a picture of the child and various information about the child including the child's name, a brief description of the child, birth date, sex, country, and ethnicity (Adoption Solutions, at 8).

6. Adoption Solutions' Parent Registry can include a personalized letter from the prospective parents to the birthmother or a photo album website (Adoption Solutions, at 2).

7. Brasseur describes increasing popularity of television game shows such as "Who Wants To Be a Millionaire?" and reality shows such as "Survivor" (Brasseur, col. 1, ll. 13-19).

8. Brasseur also notes that the Internet is an "extremely popular" interactive medium for communications and commercial transactions (Brasseur, col. 1, ll. 19-22).

9. Appellant's Specification notes that viewer participation by voting in game shows and reality television shows was known at the time of the invention (Spec. 2:6-16).

⁷ The respective website printouts comprising the Adoption Solutions reference are not individually paginated. Nevertheless, we refer to particular pages of this reference in the order in which they appear in the record.

10. The Adoption Solutions site enables prospective parents to add their websites to the Parent Registry and assist in creating Photo Album websites (Adoption Solutions, at 2).

11. According to Appellant's Specification, the term "parent-contestants" "refer[s] to a prospective parental entity, which typically is a husband and wife couple, although this term also is construed to include same-sex unions, or even single individuals, who desire to become parents" (Spec. 4:11-14).

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Discussing the question of obviousness of claimed subject matter involving a combination of known elements, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), explains:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* [v. *AG Pro, Inc.*, 425 U.S. 273 (1976)] and *Anderson's-Black Rock* [v. *Pavement Salvage Co.*, 396 U.S. 57 (1969)] are illustrative—a court must ask whether the improvement is more

than the predictable use of prior art elements according to their established functions.

KSR, 127 S. Ct. at 1740. If the claimed subject matter cannot be fairly characterized as involving the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement, a holding of obviousness can be based on a showing that “there was an apparent reason to combine the known elements in the fashion claimed.” *Id.* at 1740-41. Such a showing requires

some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. at 1741 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)) (internal quotation marks omitted).

If the Examiner’s burden is met, the burden then shifts to the Appellant to overcome the *prima facie* case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

Method steps are not ordinarily construed to require an order unless they expressly or implicitly require performance in that order. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (citing *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323 (Fed. Cir. 2001)). “First, we look to the claim language to determine if, as a matter of logic or grammar, [the method steps] must be performed in the order written.” *Altiris*, 318 F.3d at 1369. If the claim language itself does not require

performing the steps in that order, we then look to the Specification “to determine whether *it* directly or implicitly requires such a narrow construction.” *Id.* at 1370 (internal quotation marks and citation omitted).

ANALYSIS

We begin our analysis with the claim language. Claim 1 recites three steps that call for (1) providing parent-contestants; (2) broadcasting images of these contestants to receiving units with a video display; and (3) awarding at least one child available for adoption to at least one winning parent-contestant.

We note two key points regarding this claim. First, the claim’s third step of awarding the child is not tied in any way to the second step of broadcasting the contestants’ images. Second, neither the claim nor the Specification expressly or implicitly requires the steps to be performed in the recited order. *See Altiris*, 318 F.3d at 1369. Thus, the third step of awarding need not be performed last to meet the claim. That is, the claim does not preclude awarding a child before broadcasting the images of the parent-contestants.

Turning to the prior art, we find that Adoption Solutions itself amply suggests these limitations. Adoption Solutions is a website that provides, among other things, a searchable database of parents hoping to adopt a child and photo listings of children available for adoption (FF 4). The site therefore provides a way for prospective parents to peruse the listings of children available for adoption and ultimately select at least one child in those listings.

Furthermore, the Adoption Solutions site enables prospective parents to add their websites to the Parent Registry and assist in creating Photo Album websites (FF 10). These features, in effect, “broadcast” images of prospective parents to any number of visitors to the site via the Internet. As such, images of prospective parents would therefore be broadcast to multiple “receiving units” with video displays (i.e., the users’ computers displaying the web pages and associated images via their respective browsers).

These prospective parents, in our view, are “parent-contestants” given the scope and breadth of the term (*see* FF 11) and the inherently competitive nature of the adoption process. Clearly, the ultimate goal for prospective parents using the Adoption Solutions site is to adopt a selected child. Using the Adoption Solutions site, however, any number of prospective parents can theoretically select the *same child* for adoption from the limited number of children listed in the photo listings (FF 4-5). Such multiple selections would be possible since, as Appellant indicates, the site does not actually facilitate adoptions, but merely assists in initiating the process (Reply Br. 3). Thus, at least at this initial stage, these prospective parents could, in effect, “compete” for that particular child. Any disputes arising from such a “competition” would ultimately be decided by the appropriate authorities in accordance with applicable law—a resolution that would ultimately result in awarding the child to a particular “parent-contestant.”

For these reasons, we find Adoption Solutions alone amply suggests all limitations of representative claim 1. Although we find the teachings of Brasseur merely cumulative to Adoption Solutions with respect to the obviousness of claim 1, we nonetheless are not persuaded of error in the Examiner’s rejection based on both references’ collective teachings. In

short, we find that the Examiner's *prima facie* case of obviousness based on these collective teachings has at least a rational basis that has not been persuasively rebutted.

In reaching this conclusion, we acknowledge that Brasseur's contest is about money—not adoption. The reference simply has nothing to do with adoption, let alone matching parents with children available for adoption. Rather, Brasseur pertains to a game show where, each week, voters select a winner who is awarded a large sum of money. The winner then tries to spend that money in a particular time frame, or else the money is lost (FF 1-3).

Although Brasseur does not involve adoptions, the Examiner's reliance on Adoption Solutions as a basis for modifying Brasseur's game show to promote child adoptions has a rational basis in our view. As we indicated previously, the adoption process can be inherently competitive. For example, any number of prospective parents can theoretically select the *same child* for adoption from the limited number of children listed in the photo listings on the Adoption Solutions site (FF 4-5).

Assuming that the prospective parents vying for a particular child otherwise meet the requirements for adopting that child, we see no reason why the outcome of such a "competition" could not be determined, at least in part, by any known competition-deciding step(s), such as by voters selecting at least one parent-contestant based on a disclosed profile (e.g., using at least the information provided in the Parent Registry on the Adoption Solutions site (FF 4, 6, 10)). As controversial as such a spectacle may be, we see no reason why it would not have been obvious, particularly

when it is known that viewers can actively participate in a competitive process via the Internet such as in Brasseur.

We reach this conclusion emphasizing that the widespread popularity of (1) reality television shows (i.e., featuring real people, not actors), and (2) televised game shows were both significant market forces prevalent at the time of the invention. *See, e.g.*, FF 7 and 9. Furthermore, Brasseur notes that the Internet was an “extremely popular” interactive medium for communications and commercial transactions (FF 8). As such, the popularity of the Internet was also a significant market force at that time.

Brasseur’s game show leverages all three of these market forces by combining a game show, reality show, and viewer participation via the Internet (FF 1-3). Given (1) these prevailing market forces that existed at the time of the invention, (2) the inherent competitive environment that adoptions can foster, and (3) the potential entertainment value of such a competition, we see no reason why skilled artisans could not have similarly leveraged these market forces to select adoptive parents via a game/reality show format similar to that of Brasseur.

At its most fundamental level, Brasseur is premised on a simple concept: a pool of contestants compete for a single monetary prize where voters determine the winner (FF 1-3). Based on the record before us, we see no reason why such a concept could not be adapted for pools of eligible parent-contestants who would compete not for money, but rather to adopt a child—a completely different type of “prize,” but a prize nonetheless. As “bizarre” and “wrong-headed” as such a concept may be (to use Appellant’s

characterization),⁸ such a predictable variation could nonetheless have been driven by market forces prevalent at the time of the invention.⁹ Moreover, there is no evidence on the record before us that such a variation would have been beyond the level of ordinarily skilled artisans.¹⁰

For the foregoing reasons, we find the Examiner has established a *prima facie* case of obviousness based on the collective teachings of Brasseur and Adoption Solutions. In our view, combining these references to arrive at the claimed invention as the Examiner proposes is based on at least “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR*, 127 S. Ct. at 1741 (internal quotation marks and citation omitted). We therefore find no error in this approach.

We also do not find the submitted newspaper article, pertaining to a promotion of the ABC News program “20/20” involving a competition among five couples to adopt a teen mother’s baby (Evid. App’x.), sufficient to overcome the Examiner’s *prima facie* case of obviousness. First, the article is from April 2004—over three years after the filing date of the present application (Jan. 11, 2001). While this disparity is not dispositive

⁸ “It may be that the appellant’s invention is wrong-headed and bizarre....There is no requirement under U.S. law that a patentable invention must be right-headed” (App. Br. 14).

⁹ “When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *KSR*, 127 S. Ct. at 1740.

¹⁰ “[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.” *Id.*

regarding the probative value of the evidence, it does not squarely address the prevailing opinions at the time of the invention. At best, we must infer from this document that the opinions relied upon by Appellant were, in fact, prevailing at the time of the invention.

Nevertheless, even if we assume, without deciding, that the opinions expressed in the article reflected those that existed at the time of the invention, the evidence is, at best, inconclusive. It is true that several adoption professionals indicated in the article that characterizing the adoption process as a competition is “inappropriate and insensitive” (Evid. App’x., at A-7). Although ABC may have changed the wording of the show’s promotional spot in response to feedback (*Id.*), the article does not state to what extent the show itself was changed—if at all.¹¹ In any event, the article is clear that the show depicts five couples each vying to adopt a teenage mother’s child. Thus, while the network may have altered the promotional hyperbole responsive to negative feedback, there is nothing in the article to suggest that the underlying nature of the competition (i.e., five couples vying for a single child) depicted in the show itself was altered. That ABC planned to air the show despite the criticism speaks volumes as to the perceived entertainment value of such an inherently competitive process.

Moreover, the “winning” couple indicated that they “already have seen good come from [the show],” namely (1) their adoptive son, and (2) interest generated among their students at a local high school where they both taught (Evid. App’x., at A-8) (internal quotations omitted).

¹¹ See Evid. App’x., at A-7 (quoting an ABC spokesman who indicated the possibility that the show to be aired “*might* be different from the screening copy given to media.”) (emphasis added).

When considered as a whole, the newspaper article reflects both the positive and negative aspects of publicizing the inherent competitive aspects of the adoption process to a mass audience. That is, while the practice may be considered inappropriate and insensitive to some, others may find it entertaining. Moreover, the article at least suggests that other benefits can arise from such a competition including, among other things, raising awareness of the process. Thus, we do not find the newspaper article sufficient evidence to overcome the Examiner's *prima facie* case of obviousness.

For the foregoing reasons, Appellant has not persuaded us of error in the Examiner's obviousness rejection of representative claim 1. Therefore, we will sustain the Examiner's rejection of that claim, and claims 2-22 which fall with claim 1.

CONCLUSION OF LAW

Appellant has not shown that the Examiner erred in rejecting claims 1-22 under § 103. Additionally, claim 1 fails to recite statutory subject matter under § 101.

ORDER

The Examiner's decision rejecting claims 1-22 is affirmed.
No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2008-1987
Application 09/757,609

AFFIRMED

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